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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/532,961
Filing Date: April 27, 2005
Appellant(s): BRUNA, PASCAL

Raja N. Saliba
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/2/2009 appealing from the Office action mailed 11/21/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. The after final amendment of 3/23/2009 has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. As clarified in the Interview Summary of 4/8/2009, claim 22 was rejected in the final rejection under Walker et al. in view of Barberi et al. and Liou.

The appellant states in section 3 of the Appeal Brief that the provisional rejection based on non-statutory obviousness-type double patenting is not at issue. The provisional rejection has not been withdrawn and the claims have not been cancelled. Therefore, the following rejection should be reviewed on appeal:

Claims 1-3 and 6-20 are provisionally rejection on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/532,073.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,327,017	BARBERI et al.	12-2001
5,895,159	LIOU	4-1999
5,564,414	WALKER et al.	10-1996
10/532,073	NICOLAS	4-2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3 and 6-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (US 5,564,414) in view of Barberi et al. (US 6,327,017) and Liou (US 5,895,159).

Regarding claims 1, 2, 3, 10, 12, 13-17, 21, and 22, Walker et al. discloses a fluid dispensing device comprising a body (12, 112) incorporating a dispenser orifice, a reservoir (13) containing the fluid, and a dispensing member (metering valve/stem of MDI), the device being further characterized in that is comprises a dose indicator with an LCD display means (column 7, lines 30-35) that displays the number of doses delivered to the patient (abstract). A switch controls the LCD screen such that *upon actuation of the dispensing member* by a user, two portions of the switch (135) contact each other and an electric pulse is sent to the counting device (130) to change the LCD display (column 7, lines 40-50).

Walker et al. is silent as to the display requiring no energy to keep the display unchanged and only a small amount of energy to change it. However, Barberi et al. discloses a bistable nematic liquid crystal display for use small portable devices (see column 19, lines 50-55). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used a bistable nematic LCD as taught by Barberi et al. in place of the LCD of Walker et al. in order to preserve power. The modified reference would require no energy to keep the display unchanged and only a small electric pulse to change it.

Furthermore, the modified Walker et al. reference does not disclose that the energy to change the display is created by the contacting portions of the switch to create the energy while

the device is being actuated and that no battery is required to operate the device. However, Liou discloses a current producer (60) that produces an instantaneous current upon a pressing bar (31) striking an internal flint (column 2, lines 47-53) in order to avoid the use of an external power source (column 1, lines 45-55). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have replaced the battery and switch mechanism of the modified Walker et al. device with a pressing bar and flint current producer as taught by Liou in order to produce the electric pulse needed to change the LCD display without the need for an external power supply (i.e., by replacing the "striking bar" and "contacting portion" of Walker et al. seen in Figure 3B with the pressing bar and flint of Liou, respectively).

Regarding claim 11, the dose indicator disclosed by Walker et al. is thin in structure (see figure 2A).

Regarding claim 6, the electric producer of Liou transforms the mechanical movement of the striker pin into an electric pulse that would be used to change the display in the modified device.

Regarding claims 7 and 18, the interaction in the modified device would involve one portion of the device (pressing bar) striking against another portion (flint) of the device during actuation.

Regarding claims 8, 9, 19, and 20, the reservoir and striker pin are displaceable relative to the body (i.e., user presses top of reservoir/pin/pressing bar to actuate dispensing) and the contacting portion (flint) is located on the body and unable to move relative to the body (see Figures 3B and 3D). In addition, Walker et al. discloses a spring for biasing the striker pin away from the contacting portion (see figure 3D).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 and 5-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/532,073. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the copending claim and the instant claim are minor and obvious from each other. For example, the instant claim 1 is a broader version of the copending claim 5 (i.e. the instant claim 1 does not include the structural element of electronic circuit or the electric pulse coming from an impact of two elements as in the copending claim 5). In the instant claim 1, the structural elements are included in the copending claim 5. Any infringement over the copending application would also infringe over the instant claim. Hence, the instant claims 1-3 and 5-20 do not differ from the scope of the copending claims 1-8.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

(10) Response to Argument

A. There is rationale to combine the references

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In addition, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, examiner has previously discussed the motivation for combining the references in the rejection. Walker et al. teaches an inhaler with an LCD display, run from battery power, that changes upon contact of two pieces when the inhaler is actuated (i.e., when the user presses on the inhaler to dispense the medicine, electrical components touch and the switch is completed, which allows current to travel to the screen and indicate a change in the

display). Barberi et al. teaches bistable nematic crystal LCD screens for small portable devices that also run off of an electrical supply such as batteries, because bistable nematic crystals preserve power with LCD displays. Motivation for combining the references was discussed as preserving power. In addition, examiner notes that such a modification would involve mere substitution of one well known method (bistable nematic crystal LCD taught by Barberi et al.) for another (conventional LCD display of Walker et al.) to yield predictable results that do not patentably distinguish an invention over the prior art. Furthermore, it appears as though the device of Walker et al. would perform equally well with any type of well known LCD. As discussed by appellant, bistable nematic crystal displays work by changing the position of the crystals by an electric pulse. So actuating the device of Walker et al. to complete the circuit and send the electrical pulse would suffice for changing the positions of the crystals and thus, the display. Liou then teaches in column 1, lines 45-50 that one way to replace conventional electrical wire power sources (which are well known equivalents to batteries) is to use a striking bar/flint combination to produce an instantaneous electrical current. As discussed in the rejection, motivation for using the striking bar/flint teaching of Liou in the modified Walker et al. device is to avoid the need for an external power supply such as batteries which need replacement and are subject to corrosion. Liou is cited merely for teaching that electrical current can be created upon contact of two mechanical pieces without the use of an external battery supply. The fact that Liou uses the current for ignition is irrelevant. Even though Walker et al. doesn't specifically mention batteries are inadequate, it is well known that batteries corrode and need replacement, and that it would be beneficial to have a device that needed no wires, batteries, or external power source at all. In addition, there is no structure in any of the references

that would prevent the combination and such a modification appears to be a mere substitution of one well known method (using mechanical pieces to create an electrical current) for another (using batteries/external power supplies to create an electrical current) to yield predictable results that do not patentably distinguish an invention over the prior art.

In response to appellant's arguments on page 14 that both Walker et al. and Barberi et al. teach batteries, examiner contends that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). It is unimportant that these references teach batteries because the combination with Liou discloses a means for replacing an external battery supply which would allow the modified device to perform equally well. The use of a battery supply actually helps leads one to look towards Liou, who teaches a well known means of avoiding use of an external power supply when only small electrical pulses are needed in a device. Since the modified Walker et al./Barberi et al. device requires only a small electrical pulse to change the bistable nematic crystal LCD display, one would look to other well known ways of generating that electrical pulse and/or prolonging the life of the device as long as possible by not wasting power. Just because a reference discloses a feature in a device (such as a battery for generating electrical current) does not mean that there is a teaching away from other well known means for solving the same problem (creating an electrical current from mechanical striking) as suggested by appellant.

Examiner also notes that appellant seems to be focusing on the electrical pulse of Walker et al. as being for igniting a flame (or producing a "spark"). As discussed above, this is irrelevant to the use of the Liou reference in the instant rejection because Liou is cited merely for its

teaching that contacting two mechanical pieces together (such as is done with the original Walker et al. device when actuating the device to complete the circuit and change the display) can create an electrical current without use of an additional battery. This current would be sufficient for changing the location of the crystals in the modified Walker et al. device and thus changing the display as required by Walker et al.

B. All recited features are disclosed by the combination of references

In response to appellant's argument that the combination of references does not teach creating the energy as the dispenser is actuated, examiner respectfully disagrees and maintains the position held in the final action and above. Walker et al. teaches transferring the electrical pulse by completing the circuit upon actuation of the device. One of ordinary skill in the art would clearly know how to arrange the striking bar and flint of Liou in the modified device such that the contact occurs during dispensing. The combination of references is simply replacing the electrical switch components with the mechanical components of Liou to create the electrical pulse when the dispenser is actuated, since Liou teaches creating an electrical current pulse upon contact of the striking bar and flint (by pressing the bar to strike the flint). Therefore, the energy is in fact created as the device is actuated because as a user presses the inhaler down to release a dose of medicine as taught by Walker et al., the striking bar would contact the flint element to create an electrical current thereby changing the display in the modified device.

Appellant's arguments on page 16 regarding the Walker et al. reference disclosing a battery and the energy system of Liou being separate from the dispensing system are again considered a piecemeal attack on the references. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re*

Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Here, as discussed in the above paragraph, the combination of references reads on the instant claims, not the individual references themselves.

Obviousness-type Double Patenting Rejection

As appellant has provided no arguments with respect to the obviousness-type double patenting rejection over 10/532,073, the Board is requested to affirm this rejection.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Kristen C. Matter/

Examiner, Art Unit 3771

Conferees:

/Justine R Yu/
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